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OFFICE OF PETITIONS

In re Application of :
Bonsignore et al. :
Application No. 10/027,387 : ON PETITION
Filed: December 20, 2001 :
Attorney Docket No. 5037-001 :

This is a decision on the petition under 37 CFR 1.10 filed February 25, 2002, to accord the above-identified application a filing date of December 19, 2001, instead of December 20, 2001. This is also a decision on the petition under 37 CFR 1.183, filed February 25, 2002, requesting waiver of 37 CFR 1.10.

The petition under 37 CFR 1.10 is **dismissed**.

The petition under 37 CFR 1.183 is **dismissed**.

Facts:

The instant application is a continuation-in-part of 09/721,074, which was filed on November 22, 2000, and was pending on both December 19, 2001, and December 20, 2001.

At the main Chicago post office, the last pick up from any Express Mail drop box is 9:00 p.m. The main Chicago post office is the only twenty-four hour facility in Chicago. Therefore, if one waits until after 9:00 a.m. to mail an Express Mail Package, "the only possible manner for complying with 37 C.F.R. §1.10 is to actually deliver the filing with a postal service employee [at the main Chicago post office]."[1]

The instant application, along with the Express Mail package, was not prepared until 11:30 p.m. on December 19, 2001. The attorney left the office and arrived at the post office at approximately 11:45 p.m. The attorney arrived at the transaction counter at 11:50 p.m. The line held approximately 20-25 persons with multiple Holiday packages. Only one employee was working at the counter. The attorney decided he would not reach the counter by midnight and chose to deposit the application in a drop-box. The application was deposited at 11:51 p.m. The last scheduled pick up for the drop-box was prior to 11:51 p.m.

Petitioner requests a filing date of December 19, 2001, rather than December 20, 2001.

[1] Petition, page 2.

The instant petition is not accompanied by a showing in compliance with 37 CFR 1.10.

37 CFR 1.10(d) requires "the correspondence [to be] deposited in the 'Express Mail Post Office to Addressee' service prior to the last scheduled pickup for that day."

Petitioner has failed to establish that the correspondence was deposited in the receptacle prior to the last scheduled pickup for December 19, 2001.

Petitioner has failed to provide a showing that an extraordinary situation exists such that justice requires waiver of 37 CFR 1.10.

The Law:

In order for a petition under 37 CFR 1.183 to be granted, petitioner must demonstrate the existence of an extraordinary situation where justice requires waiver of one or more federal regulations. It is the responsibility of the Commissioner to determine the definitions of the terms "extraordinary" and "as justice requires" as the terms are used in 37 CFR 1.183.[2] The Commissioner drafted the federal regulations which may be waived including 37 CFR 1.183. The Commissioner is the party responsible for determining when a party has demonstrated that an "extraordinary" situation exists such that "justice requires" waiver of a federal regulation.

In determining when waiver is appropriate, the Office *may* consider the circumstances when courts have exercised their equitable powers to waive requirements of a statute or regulation on behalf of a party. Courts are permitted to waive certain statutory requirements such as statutory time limits.[3] Courts, in determining when waiver is proper, have required due diligence and have required more than a "garden variety claim of excusable neglect."[4] The Federal Circuit has stated, "Equitable powers . . . should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence."[5] Factors which may not justify

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[2] See Bowles, Price Administrator v. Seminole Rock & Sand Co., 325 U.S. 410, 413-414, 89 L. Ed. 1700, 1702, 65 S. Ct. 1215, 1217 (1945) ("Since this involves the interpretation of an administrative regulation a court must necessarily look to the administrative construction of the regulation if the meaning of the words used is in doubt. . . . [T]he ultimate criterion is the administrative interpretation, which becomes of controlling weight unless it is plainly erroneous or inconsistent with the regulation.") "In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")).

[3] See Wood-Ivey Sys. Corp. v United States, 4 F.3d 961, 964 (Fed. Cir. 1993) (Plager, J., concurring) ("Since Irwin [v. Department of Veterans Affairs, 498 U.S. 89, 112 L. Ed. 2d 435, 111 S. Ct. 453, (1990)], compliance with statutory time limits is no longer jurisdictional, in the old sense that when a Congressionally specified time limit had expired a court had no power to entertain the case. The presumption is now to the contrary. The court has jurisdiction to entertain the suit and to determine on the merits if equitable relief from the time bar is warranted.")

[4] See Wiggins v. State Farm Fire and Casualty Co., 153 F. Supp. 2d 16, 21 (D. D.C. 2001) ("A court can equitably toll the statute of limitations . . . plaintiff will not be allowed extra time to file unless he has exercised due diligence, and the plaintiff's excuse must be more than a 'garden variety claim of excusable neglect.'") (citations omitted).

[5] U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983) (citations omitted) ("Lockheed had several means at its disposal which it could have employed to guarantee compliance with the regulation, yet it neglected to use any of them. Equitable powers . . . should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence."); See also: Grymes v. Sanders et al., 93 U.S. 55, 61; 23 L. Ed. 798, 801 (1876)

tolling include: pro se status, illiteracy, deafness, lack of legal training, lack of knowledge of the law, lack of knowledge of a legal process, and lack of legal representation.[6] An attorney's lack of knowledge, misinterpretation of a law, miscalculation of a time period, and failure to exercise due care and diligence will not justify waiver.[7]

Application of the law to the instant facts:

Waiver of 37 CFR 1.10 is inappropriate unless petitioner can demonstrate that failure to waiver the rule will result in actual harm to petitioner AND that petitioner exercised reasonable care and diligence.

Petitioner has not demonstrated that the application will be denied patentability due to the later filing date. The fact that it *might* be denied patentability is insufficient.[8] Petitioner has not shown that the assignment of the December 20, 2001 filing date to the application has resulted in any actual harm to petitioner. If the patentability of the application is not affected by the assignment of a later filing date, then justice does not require waiver of the rule.

Assuming that petitioner can demonstrate that failure to assign the date requested will result in actual harm, why was the application not fully prepared prior to 11:30 p.m. on December 19, 2001? As stated in the petition, if one waits until after 9:00 a.m. to mail an Express Mail Package, "the only possible manner for complying with 37 C.F.R. §1.10 is to

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("Mistake, to be available in equity, must not have arisen from negligence. . . . The party complaining must have exercised at least the degree of diligence 'which may be fairly expected from a reasonable person.') (citing Kerr on Fraud and Mistake, 407); Garcia v. Office of Personnel Management, 2001 U.S. App. LEXIS 21616, 6 (Fed. Cir. 2001) ("Equity will not intervene, however, to protect a claimant from his or her own failure to exercise due diligence in preserving their legal rights.") (citing Irwin v. Department of Veterans Affairs, 498 U.S. 89, 95 (1990)); Goetz & Goetz v. Secretary of Health and Human Services, 2001 U.S. App. LEXIS 943, 5 (Fed. Cir. 2001) ("the special master's finding of a lack of due diligence was not arbitrary, capricious, or an abuse of discretion, and precludes the application of equitable tolling.") (citing Baldwin County Welcome Ctr. V. Brown, 466 U.S. 147, 151, 80 L. Ed. 2d 196, 104 S. Ct. 1723 (1984) which states, "One who fails to act diligently cannot invoke equitable principles to excuse their lack of diligence.")

[6] See Felder v. Johnson, 204 F.3d 168 171-172 (5th Cir. 2000) (Pro se status is not "rare and exceptional" circumstance, but is typical of those bringing a 28 U.S.C. § 2254 claim. "Mere ignorance of the law or lack of knowledge of filing deadlines does not justify equitable tolling or other exceptions to a law's requirements.") (citing United States v. Flores, 981 F.2d 231, 236 (5th Cir. 1993) as "holding pro se status, illiteracy, deafness, and lack of legal training are not external factors excusing abuse of the writ."; citing Barrow v. New Orleans S.S. Ass'n, 932 F.2d 473, 478 (5th Cir. 1991) as "holding equitable tolling . . . within the Age Discrimination in Employment Act not warranted by plaintiff's unfamiliarity with legal process, his lack of representation, or his ignorance of his legal rights.", (other citations omitted)).

[7] See Harris v. Hutchinson, 209 F.3d 325, 330-331 (4th Cir. 2000) (Plaintiff argues that he relied on "negligent and erroneous advice" of his attorney. Attorney agrees his advice was erroneous. The court holds, "[A] mistake by a party's counsel in interpreting a statute of limitations does not present the extraordinary circumstance beyond the party's control where equity should step in to give the party the benefit of his erroneous understanding.") (citing Taliani v. Chrans, 189 F.3d 597, 598 (7th Cir. 1999) as "holding that a lawyer's miscalculation of a limitations period is not a valid basis for equitable tolling."; citing Sandvik v. United States, 177 F.3d 1269, 1272 (11th Cir. 1999) (per curiam) as "refusing to toll the limitations period where the prisoner's delay was assertedly the result of a lawyer's decision to mail the petition by ordinary mail rather than to use some form of expedited delivery."; citing Gilbert v. Secretary of Health and Human Services, 51 F.3d 254, 257 (Fed. Cir. 1995) as "holding that a lawyer's mistake is not a valid basis for equitable tolling."; other citations omitted.)

[8] See Nitto Chemical Industry. Co., Ltd. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) ("As a final matter, Nitto suggests that its patent applications have been prejudiced by the Commissioner's failure to give the applications a filing date of February 28, 1991. Opp. at 9. The Commissioner has acknowledged that, without the benefit of the foreign patent filing date of February 28, 1990, the patentability of Nitto's inventions could be adversely affected. Motion at 4. However, Nitto did not submit evidence showing that the inventions claimed in the two applications have been, or will be, denied patentability over applications filed between February 28, 1990, and May 2, 1991. Reply at 3-4. Thus, the Commissioner had no basis on which to determine whether "justice required" him to award Nitto's applications the earlier filing date.")

actually deliver the filing with a postal service employee [at the main Chicago post office]."[9] Petitioner could have avoided being forced into such a situation by preparing the application on an earlier date or at an earlier time. When was the first date that petitioner learned of the need to file the instant application? What steps were taken at that time to ensure the application would be filed timely?

Those who file at the end of a statutory bar year (35 U.S.C. 102(b)) or a priority year (35 U.S.C. 119) or who delay filing a continuing application until the last possible day for establishing continuity (35 U.S.C. 120 or 121), do not leave any opportunity to overcome any error which might occur in filing the application. In this case, petitioner risked a line at the post office during the Christmas holiday season. Petitioner also risked other problems at the post office or traffic delay. How many other packages had been mailed during prior Christmas holiday seasons between 11:50 p.m. and 12:00 p.m.? Had problems existed before? Should petitioner had anticipated problems such as possible long lines, lack of adequate employees at the counter, etc.?

A party exercising due care would not wait to file the application until the last ten minutes if the filing date was essential. Petitioner was aware, or should have been aware, that waiting until the last moment would preclude the use of a dropbox after the last scheduled pickup of the day. The Office stated in a final rulemaking package in 1983,

> Comment: One person questioned what treatment will be accorded a paper placed in an 'Express Mail' box receptacle after the box has been cleared for the last time on a given day.
>
> Reply: The paper will be considered to be deposited as of the date of receipt indicated on the 'Express Mail' mailing label by the Postal Service clerk.[10]

An applicant may delay action until the end of a time period.. In doing so, however, the applicant must assume the risk attendant to such delay. Petitioner was aware the application needed a filing date of December 19, 2001 but waited until 11:51 to arrive in line at the post office.

Petitioner has failed to establish that justice requires waiver of the rule.

Since the petition lacks a showing that this is an extraordinary situation in which "justice requires" suspension of the rules, the petition under 37 CFR 1.183 is subject to dismissal.

Conclusion:

Congress, through 35 USC 21, chose to allow the Commissioner, at his discretion, to create rules which would allow the filing date to be the date of deposit with the USPS, rather than the date of receipt by the Patent and Trademark Office. The Commissioner had the responsibility of deciding exactly what group of applications would be accorded a filing date as of the date of receipt by the Office and which group would be given a filing date as of the date of deposit with the USPS. The Commissioner chose to allow the second group to only be comprised of applications mailed in compliance with 37 CFR 1.10. The purpose of 37 CFR 1.183 is to deal with extraordinary circumstances where justice requires waiver of a rule, not to expand the size of the second group by circumventing 37 CFR 1.10. Petitioner has failed to establish that this is an extraordinary situation where justice requires waiver of the rule.

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[9] Petition, page 2.

[10] 48 Fed. Reg. 2696-2714 (January 20, 1983), 1027 Off. Gaz. Pat. & TM Office 9 (February 1, 1983).

The file is now being forwarded to the Office of Initial Patent Examination for further processing.

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